

**REMARKS**

Pursuant to the present amendment, claims 1, 2, 4, 7, 8, 9, 14, 19 and 22 have been amended and claims 3 and 31-65 have been canceled. Thus, claims 1-2 and 4-30 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

As an initial matter, claims 31-65 have been canceled as they are directed to a non-elected invention that was the subject of a previous restriction requirement issued by the Patent Office. Applicant specifically reserves the right to pursue the subject matter set forth in claims 31-65 in a later filed application.

In the Office Action, claims 1-7, 9-12, 14-17, 12-23, 25 and 26 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Nelson (U.S. Patent No. 3,770,247). Claim 24 was rejected under 35 U.S.C. § 103 as allegedly being obvious in view of Nelson and Steinke (U.S. Patent No. 6,024,122). Claims 1-4, 6-9, 11-14, 16-19, 21, 22 and 25-27 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Gessaman (U.S. Patent Publication No. 2004/0099832). Claim 24 was rejected under 35 U.S.C. § 103 as allegedly being obvious in view of Gessaman and Steinke. Applicant respectfully traverses the Examiner's rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*,

231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Pursuant to the present amendment, independent claims 1, 19, 14, 19 and 22 have been amended to recite that the device comprises an opening formed in the bonnet. As thus amended, it is respectfully submitted that these independent claims, as well as all claims depending therefrom, are allowable over the prior art of record.

Nelson, one of the Examiner's primary references, discloses a valve wherein a passage 96 is formed in the valve stem 30 for pressure-balancing purposes. Figure 1; Col. 4, ll. 21-27; Col. 5, ll. 24-32. Gessaman, the Examiner's other primary reference, discloses a valve wherein a pressure passage 48 is formed in the plug portion 38 of the valve member 34. Figure 2; ¶¶ 19, 20.

As thus understood, it is respectfully submitted that the subject matter defined by independent claims 1, 9, 14, 19 and 22 is allowable over the art of record. None of the cited prior art references disclose a valve comprised of an opening formed in the bonnet as now set forth in these claims. Thus, the currently pending claims are not anticipated by the prior art of record.

Moreover, there is no suggestion in the art of record to modify the teachings of the prior art so as to arrive at Applicant's invention. First, even if the art of record were combined, such a combination of art would not include all of the claimed limitations of the pending claims. That is, at a minimum, the combined art would not disclose a valve comprising an opening formed in the bonnet, as set forth in the pending claims. Moreover, there is simply no suggestion in the prior art to modify the prior art so as to arrive at Applicant's invention. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. If anything, the prior art can be understood to teach away from the present invention in that the valves disclosed in Nelson and Gessaman disclose bonnets, but the pressure balancing openings in Nelson and Gessaman are not formed in the bonnet. It is respectfully submitted that any attempt to assert that the pending claims are obvious in view of the prior art of record would necessarily involve an improper use of hindsight using Applicant's disclosure as a roadmap. For at least these reasons, it is respectfully submitted that the pending claims are not obvious in view of the art of record.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON  
CUSTOMER NO. 23720

Date: June 15, 2005



J. Mike Amerson  
Reg. No. 35,426  
10333 Richmond, Suite 1100  
Houston, Texas 77042  
(713) 934-4056  
(713) 934-7011 (facsimile)

ATTORNEY FOR APPLICANT